REMARKS

Entry of the foregoing, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.112, are respectfully requested.

By the foregoing amendment, claim 1 has been amended and new claims 50-51 have been added. Support for the amendments to claim 1 as well as for new claims 50-51 can be found throughout the originally filed application. Thus, no new matter has been added.

Turning now to the merits of the Office Action, the Examiner has rejected claims 1-3 and 22-24 under the judicially created doctrine of obviousness-type double patenting as purportedly being unpatentable over claims 1-6 of United States Patent No. 6,559,146 ("the '146 patent"). This rejection is respectfully traversed.

To expedite prosecution in the present application and not to acquiesce to the Examiner's rejection, the last paragraph of claim 1 has been amended. As such, claims 1-6 of the '146 patent are patentably distinct from the claims of the present application which are currently under examination. In view of the above, withdrawal of this obviousness-type double patenting rejection is respectfully requested.

Claim 1-3 have been rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for compounds according to formula (I) wherein Q' is hydrogen or certain cyclic groups, allegedly does not reasonably provide enablement for compounds. This rejection is respectfully traversed.

To expedite prosecution in the present application and not to acquiesce to the Examiner's rejection, claim 1 has been amended such that Q' is directed to hydrogen and certain cyclic groups. Since the Examiner has admitted that the claims are

enabling for compounds according to formula (I) wherein Q' is hydrogen or certain cyclic groups, withdrawal of this enablement rejection is respectfully requested.

Claims 1-3 and 22-24 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Annoura et al., United States Patent No. 6,559,146. This rejection is respectfully traversed.

It is noted that the Examiner has set forth the incorrect version of 35 U.S.C. § 102(e) as it applies to the present situation. The '146 patent is based on an international application filed prior to November 29, 2000, *i.e.*, on October 14, 1999. Accordingly, the pre-AIPA version of 35 U.S.C. § 102(e) applies. *See* M.P.E.P. § 2136. The pre-AIPA version states that a person is not entitled to a patent when:

> the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this titles before the invention thereof by the applicant for patent.

The date in which the '146 patent satisfied the requirements of paragraphs (1), (2), and (4) of section 371(c) is indicated on the front of the patent as being November 1, 2000. The present application, however, claims priority to a Japanese application filed on April 13, 2000, which is before the November 1, 2000 date for the '146 patent.

Applicants have perfected their claim for priority. The Examiner has acknowledged that the certified copy of the Japanese Priority document was received in this national stage application from the International Bureau. Further, a certified translation of the Japanese priority document (Application No. JP 2000-112100) was filed at the time the national stage application was filed with the United States Patent and Trademark Office. However, for the

Examiner's convenience, applicants have submitted herewith another copy of the certified English language translation of the Japanese priority document.

In view of the above, the '146 patent is not applicable prior art. As such, the Examiner is respectfully requested to withdraw the alleged anticipation rejection under 35 U.S.C. § 102(e).

Claims 1-3 and 22-24 have also been rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Annoura et al., United States Patent No. 6,559,146. This rejection is respectfully traversed.

As set forth above, the '146 patent is not proper prior art and thus should not be applied against applicants' claimed invention with regard to either an anticipation or obviousness rejection.

Even if the '146 patent qualified as prior art under section 102(e), section 103(c) provides that subject matter developed by another person shall not preclude patentability under section 103 where the application and prior art reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made. Here, the present application and the '146 patent, at the time the invention of the present application was made, owned by, or subject to an obligation of assignment to the person. This statement alone is sufficient evidence of common ownership. *See* M.P.E.P. § 706.02(l)(2), at 700-55 (May, 2004).

In light of the above, the Examiner is respectfully requested to withdraw this rejection under 35 U.S.C. § 103(a).

In view of the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order. Such action is earnestly solicited.

In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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